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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------|
| 10/624,780 | 07/22/2003 | Robert J. Sheppard | SHEPP-002BUS | 6786 |
| 22494 | 7590 | 08/27/2004 | EXAMINER | |
| DALY, CROWLEY & MOFFORD, LLP SUITE 101 275 TURNPIKE STREET CANTON, MA 02021-2310 | | | MORRISON, NASCHICA SANDERS | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3632 | | |

DATE MAILED: 08/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/624,780 | SHEPPARD, ROBERT J. |
| | Examiner | Art Unit |
| | Naschica S Morrison | 3632 |

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 July 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 July 2003 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>50504</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

This is the first Office Action for serial number 10/624,780, Keyboard Wrist Support, filed on July 22, 2003. Claim 1 is pending.

Priority

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date (as a continuation of 09/499,434) under 35 U.S.C. 120 as follows: The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent, 09/499434, or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

This application repeats a substantial portion of prior Application No. 09/499,434, filed 2/7/00, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Specification

The disclosure is objected to because of the following informalities: on page 1, line 7, insert --now US Patent 6,619,597,-- after "SUPPORT,"; on page 14, on lines 20 and 23, ",242" after "240" should be deleted; on line 22, "250238, 242" should be --238, 242--; on line 30 "230" should be --234--; regarding page 15, lines 25 - line 2 of page 16, the description of the wrist support 250 is confusing and does not match the drawings (especially Fig. 14); on page 16, on line 2, delete "[(CORRECT?)]"; on line 9 "256" should be --252--; and on lines 11-14, delete the sentence beginning "[PLEASE DESCRIBE". Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference characters not mentioned in the description: 232 in Fig. 13; 284 and 286 in Fig. 14. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for lines 1-12 of the claim, does not reasonably provide enablement for a portable computer including an additional platform as recited in line 13. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification and drawings do not describe nor show an embodiment of the portable computer including a platform that is movable over a plane in which the keyboard is disposed and further including a platform that is substantially coplanar with the keyboard.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164

USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1, as best understood, is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,619,537 in view of US 6,577,502 to DiStefano et al. (DiStefano). Claim 1 of U.S. Patent No. 6,619,537 recites all of the limitations of the claims including a portable computer comprising: a chassis containing a data processor, an alphanumeric keyboard, a display and support structure a wrist support comprising a platform adapted to support a user's palms or wrist wherein said platform is slidably coupled to the support structure in said chassis and wherein, when in use, said wrist support is movable with respect to said keyboard such that said wrist support moves in a plane above a plane in which the keyboard is disposed and said wrist support can move over a surface of said chassis which is in the same plane as the keyboard, and wherein said wrist support is provided having a width substantially equal to the width of said chassis and having a length such that when said wrist support in a closed position the wrist support covers a surface of said chassis which is in the same plane as the keyboard. Claim 1 of US Patent No. 6,619,537 does not recite a platform which is substantially coplanar with respect to said keyboard. DiStefano teaches a portable computer (20) including a platform (42) substantially coplanar with a

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keyboard (24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the portable computer to include a platform substantially coplanar to the keyboard because one would have been motivate to provide a platform, substantially level with the keyboard, on which the user could rest his/her wrists while accessing a track pad and the keyboard as taught by DiStefano (col. 2, lines 26-28).

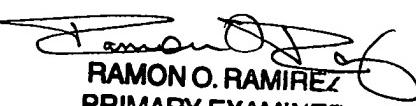
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6654230 to Jones et al. discloses a rotational wrist pad.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Naschica S. Morrison, whose telephone number is (703) 305-0228. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this Application should be directed to the Technology Center receptionist at (703) 306-1113.


Naschica S. Morrison
Patent Examiner
Art Unit 3632
8/20/04


RAMON O. RAMIREZ
PRIMARY EXAMINER